APPENDIX A — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DATED AND FILED OCTOBER 4, 1999

United States Court of Appeals for the Federal Circuit

99-1325

ABBOTT LABORATORIES,

Plaintiff-Appellant,

v.

MYLAN PHARMACEUTICALS, INC.,

Defendant-Appellee.

ON MOTION

Before LOURIE, RADER, and BRYSON, *Circuit Judges*.

BRYSON, *Circuit Judge*.

ORDER

Mylan Pharmaceuticals, Inc. renews its motion for summary affirmance of the judgment of the United States District Court for the Northern District of Illinois. Abbott Laboratories opposes.

Abbott appeals from the district court's decision granting summary judgment to Mylan and dismissing Abbott's claim of infringement against Mylan. The basis for the district

court's decision stemmed from a prior suit finding the patent at issue invalid, a finding that this court recently upheld on appeal. *See Abbott Laboratories v. Geneva Pharmaceuticals, Inc.*, 98-1593, -1594, -1595, 1999 U.S. App. LEXIS 14804 (Fed. Cir. July 1, 1999).

Summary affirmance of a case "is appropriate, *inter alia*, when the position of one party is so clearly correct as a matter of law that no substantial question regarding the outcome of the appeal exists." *Joshua v. United States*, 17 F.3d 378, 380 (Fed. Cir. 1994) (summarily affirming the Court of Federal Claims' dismissal of a complaint). Mylan contends that our decision in *Geneva* controls the outcome of the instant appeal. Abbott, in response to Mylan's renewed motion, primarily argues that the court should defer ruling on the motion until the court decides Abbott's petition for panel rehearing and rehearing en banc in *Geneva*. The court denied Abbott's petition in an August 5, 1999 order.

We agree with Mylan that our decision in *Geneva* controls the outcome of this appeal. Thus, because no substantial question exists regarding the outcome of the instant appeal, the court summarily affirms the judgment of the district court.

Accordingly,

IT IS ORDERED THAT:

(1) Mylan's renewed motion for summary affirmance is granted.

Appendix A

(2) Each side shall bear its own costs.

FOR THE COURT

OCT -4 1999
Date

s/ William C. Bryson
William C. Bryson
Circuit Judge

APPENDIX B — MEMORANDUM OPINION AND ORDER OF THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF ILLINOIS, EASTERN DIVISION DATED MARCH 4, 1999

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

No. 97 C 5450

ABBOTT LABORATORIES,
an Illinois corporation,

Plaintiff,

v.

MYLAN PHARMACEUTICALS, INC.,
a West Virginia corporation,

Defendant.

No. 98 C 1280

ABBOTT LABORATORIES,
an Illinois corporation,

Plaintiff,

v.

MYLAN PHARMACEUTICALS, INC.,
a West Virginia corporation,

Defendant.

Appendix B

MEMORANDUM OPINION AND ORDER

Plaintiff Abbott Laboratories ("Abbott") filed these two actions[1] for patent infringement against defendant Mylan Pharmaceuticals, Inc. ("Mylan") under 35 U.S.C. § 271(e)(2). Mylan moves for summary judgment, arguing that claim 4 of the patent is invalid.[2] For the reasons set forth below, the motion is granted.

Background

Since 1987, Abbott has sold terazosin hydrochloride, a drug for the treatment of hypertension,[3] under the trademark HYTRIN. In 1997, Mylan sought approval from the U.S. Food and Drug Administration ("FDA") to market a generic version of HYTRIN containing anhydrous terazosin hydrochloride.[4] Abbott claims the capsules Mylan seeks to

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1. Each of the suits, filed seven months apart, deals with a different dosage strength (or strengths) of the generic terazosin hydrochloride capsules that Mylan seeks approval to market (Case No. 97 C 5450, 5 mg; Case No. 98 C 1280, 1 mg, 2 mg and 10 mg). On May 5, 1998, the cases were consolidated pursuant to Fed. R. Civ. P. 42(a) and N.D. Ill. Local R. 2.31.

2. Mylan originally sought a ruling that claim 4 was both invalid and unenforceable. In a subsequent clarification, Mylan stated it seeks summary judgment based on invalidity only. (Def.'s Reply Br. in Supp. of Mot. for Summ. J. at 3.)

3. HYTRIN also is used in the treatment of benign prostatic hyperplasia.

4. Mylan's initial submission to the FDA requested approval to market 5 mg capsules. Subsequently, it amended its abbreviated new drug application ("ANDA") to include 1 mg, 2 mg and 10 mg dosage strengths as well.

market would infringe claim 4 of its U.S. Patent No. 5,504,207 ("the '207 patent"). However, Mylan contends claim 4 is invalid and that its capsules therefore would not infringe the '207 patent.

Collateral Estoppel

Claim 4, which claims a crystalline form of anhydrous terazosin hydrochloride (called Form IV), has already been held invalid. *Abbott Lab. v. Geneva Pharm., Inc.*, Nos. 96 C 3331, 96 C 5868, 97 C 7587, 1998 WL 566884, at *7 (N.D. Ill. Sept. 1, 1998) (Gottschall, J.) [hereinafter *Geneva*]. The invention at issue, Form IV terazosin hydrochloride, was found to be on sale more than one year before Abbott filed its application for the '207 patent. *Id.* Hence, claim 4 was held invalid under 35 U.S.C. § 102(b). *Id.*

A judgment of invalidity generally bars the patentee from relitigating the issue. *Blonder-Tongue Lab. v. University of Illinois Found.*, 402 U.S. 313, 330-34, 350 (1971); *Mississippi Chem. Corp. v. Swift Agric. Chemicals Corp.*, 717 F.2d 1374, 1376 (Fed. Cir. 1983). Unless the patentee can show she did not have a fair opportunity procedurally, substantively and evidentially to pursue her claim the first time, she is collaterally estopped from relitigating the validity question. *Blonder-Tongue*, 402 U.S. at 333; *Mississippi Chem.*, 717 F.2d at 1376, 1379. There is nothing here to indicate Abbott did not have such a full and fair chance to litigate its claim in *Geneva*.[5] *See Blonder-Tongue*, 402 U.S. at 333.

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5. Abbott contends I should stay these proceedings until its appeal in *Geneva* is decided by the Federal Circuit. Abbott argues,

(Cont'd)

Appendix B

Accordingly, Mylan's motion for summary judgment is granted. There is no genuine issue of material fact as to the invalidity of claim 4 of the '207 patent, Fed. R. Civ. P. 56(c); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986), and therefore no genuine issue as to whether Mylan's proposed product infringes that claim. It does not.

Conclusion

For the foregoing reasons, Mylan's motion for summary judgment is granted. Abbott is collaterally estopped from asserting the validity of claim 4 of the '207 patent.

ENTER ORDER:

s/ Elaine E. Bucklo
Elaine E. Bucklo
United States District Judge

Dated: March 4, 1999

(Cont'd)
inter alia, that such a stay would avoid any resulting inefficiency if *Geneva* were reversed, and thus would promote judicial economy. However, the *Blonder-Tongue* estoppel doctrine applies even when the earlier decision is on appeal. *Pharmacia & Upjohn Co. v. Mylan Pharm., Inc.*, 5 F. Supp. 2d 399, 407 (N.D.W.Va. 1998) (citing *Iron Ore Co. of Canada v. Dow Chem. Co.*, 177 U.S.P.Q. 34, 59_ (D. Utah 1972)). I decline to order a stay in this instance.

APPENDIX C — JUDGMENT OF THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF ILLINOIS, EASTERN DIVISION DATED MARCH 5, 1999

United States District Court
Northern District of Illinois
Eastern Division

Case Number: 98 C 1280
& 98 C 5450

Abbott Laboratories

v.

Mylan Pharmaceuticals, Inc.

JUDGMENT IN A CIVIL CASE

* * *

■ Decision by Court. This action came to hearing before the Court. The issues have been heard and a decision has been rendered.

IT IS HEREBY ORDERED AND ADJUDGED that pursuant to the Court's Memorandum Opinion and Order, judgment is entered and favor of defendant Mylan Pharmaceuticals, Inc. and against plaintiff Abbott Laboratories. Plaintiff Abbott Laboratories is collaterally estopped from asserting the validity of claim 4 of the '207 patent.

Appendix C

Michael W. Dobbins,
Clerk of Court

Date: 3/5/1999

s/ William J. Stasick
William J. Stasick,
Deputy Clerk